

REMARKS

Claims 1 and 3-9 are pending. Claim 1, the only independent claim, has been amended.

The Finality of the Office Action is Improper and Should be Withdrawn

In the most recent Office Action, a new ground of rejection, i.e., based on new art, was applied in rejecting the claims. However, the new Action was made final, based on the position taken, at page 4 of the Office Action, that “Applicant’s amendment necessitated the new grounds of rejection.” This position is not correct.

First, the previous rejection was based upon a reference, Ohuchi et al., that included *no marking member* of any kind, a fact that had been pointed out in previous responses and during the telephone interview of July 11, 2006, and thus did not meet the terms of claim 1 even prior to the amendment of that claim.

Second, the prior Office Action incorrectly alleged that an embedded structure of Ohuchi et al, in particular post 4, which is invisible when the chip is viewed externally (and only shown in a cross-sectional drawing), corresponded to the recited marking member. However, this element could not have corresponded to a “marking member” of any kind because it was not visible, the tops of posts 4 being covered by the solder balls 7.

Third, even if the solder balls covering the tops of the posts 4 were to be removed, the outline of the top of each post 4 would be *circular*, because the posts 4 are cylindrical in shape. Thus, even if the tops of the posts 4 had been viewable, which they were not, they would not include at least one linear portion when the marking member is viewed in the vertical direction, as had been recited in claim 1 before the amendment.

For at least these reasons, the new grounds of rejection were actually necessitated by deficiencies and technical inaccuracies in the previous Office Action and the application of the art used in that Action, and *not* by the amendment to claim 1. The amendment to claim 1 was simply

made, at the request of the Examiner during the July 11, 2006 interview, to recite what was already being claimed, in a manner thought by the Examiner to be more even more clear.

As was stated in the previous amendment, at pages 7-8:

“During the interview, the Examiner indicated that she now understood the differences between the marking member of claim 1 and post 4 of Ohuchi et al. The Examiner requested that it be made even more clear that the marking member’s linear portion may be viewed when looking at the chip package from outside the package, for example from above, or in a plan view.”

In consideration of the Examiner’s remarks, claim 1 has been amended, *without narrowing it, to make even more clear what is believed to have already been implicit*. The outline shape includes the linear portion when viewing the chip package externally, and in the vertical direction. Examples of viewing from the vertical direction would be, for example, viewing the chip package from above, or in a plan view.” (Emphasis added).

However, even before the amendment, as was pointed out in previous responses, and during the interview, claim 1 clearly recited features simply not present in the Ohuchi et al. reference. For example, prior to amendment, the marking member in claim 1 was recited as including “at least one linear portion as viewed from the vertical direction.” As discussed above, the tops of posts 4, even if they could have been “viewed from the vertical direction,” which they could *not*, were *circular* and therefore did not have a linear portion. Moreover, the fact that the posts 4 were not visible from *any* direction was enough to obviate a rejection alleging that the posts corresponded to the recited marking member, which is, and *has been*, recited as being *viewable* in the vertical direction.

In view of the above, making the Office Action final was improper at least because the new grounds of rejection were *not* based on the amendment but rather were based on the incorrect application of the prior art in the previous Office Action. It is therefore requested that the finality of the current Office Action be withdrawn.

New Rejections

Claims 1 and 3-9 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,787,892 (Furuya et al.). Applicant submits that amended claim 1 is patentable over the cited reference for at least the following reasons.

Amended claim 1 recites, *inter alia*, that the marking member includes at least one linear portion, and the external electrodes each have a circular shape when viewing the chip package externally in a vertical direction when the semiconductor chip is held horizontally. The outline shape of the marking member includes at least one linear portion when viewing the chip package in the vertical direction. The external electrodes are arranged in a peripheral area of the main surface and the marking member is arranged in a central area of the main surface in which no external electrode is arranged.

Furuya et al., on the other hand, shows an index mark that is arranged in the corner of the chip, as shown in Figure 3. In another embodiment, shown, e.g., in Figure 4, the index mark is arranged purposely outside of the central area “C.” “[The] index mark may be any external connection terminal *other than those near the center.*” Col. 7, lines 6-7 (Emphasis supplied).

Furuya et al. does not teach or suggest arranging a marking member in a central area of the surface of the chip, and in fact teaches away from placing it in such an area. For at least this reason, amended claim 1 is believed patentable over Furuya et al.

In view of the above, amended independent claim 1 is believed to clearly distinguish over the cited prior art.

The other claims in this application are each dependent from amended independent claim 1 discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Entry of this amendment is believed proper at least because the Office Action should not have been made final. In any event, this amendment is believed to clearly place this case in condition for allowance, and its entry is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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